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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,288

09/11/2003

Michael Zung

16497.138.1.1.2.1

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57360

7590

08/03/2009

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EXAMINER

MENDOZA, MICHAEL G

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

08/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/660,288	<b>Applicant(s)</b> ZUNG ET AL.	
	<b>Examiner</b> MICHAEL G. MENDOZA	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,10-14,16-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,10-14,16-18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/21/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 7/21/2009 have been fully considered but they are not persuasive. The applicant argues that there is no motivation for modifying Takamoto with Ogburn. The examiner disagrees. Takamoto discloses the need for a cutting device to cut a suture. Ogburn teaches the use of a blade for cutting a suture. The device of Ogburn fulfills the need of a cutting device of Takamoto.
2. The applicant allows argues that Ogburn teaches away from some of the modifications. However, Ogburn is not the primary reference and is used as a teaching reference for the use of a stationary cutting blade. The device of Ogburn is not the device being modified.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5, 11-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamoto et al. 7063710 in view of Field et al. 6511489.
5. Takamoto et al. teaches a suturing device comprising: a housing having a proximal end and a distal end (see. fig 1); a needle actuation handle (3 + 5) disposed at the proximal end of the housing; a movable handle (3 + 5); a shaft (1) at least partially disposed within a portion of the housing and extending distally from the distal end of the

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housing; and a needle movable within a needle lumen (see fig. 4) associated with the shaft and that extends toward a proximal end of the housing, the needle being attached to a length of suture, the needle (6) having a tapered tip, the tapered tip being initially oriented toward the distal end of the housing. It should be noted that Takamoto et al. fails to teach a suture cutting blade positioned on the housing.

6. Field et al. teaches a suturing device with a common cutting blade positioned on the housing for cutting a suture (col. 7, lines 4-23). Takamoto et al. teaches the need of a cutting device to cut the suture when suturing is complete (col. 9, lines 1-3).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Takamoto et al. in view of Field et al. to allow for cutting of excess suture material after suturing is complete.

7. Takamoto/Field teaches wherein the housing further includes a proximal end, and the blade is positioned near the distal end of the housing; wherein the housing is a hollow body having a proximal opening and an inner surface, and the blade is mounted on the inner surface (see fig. 2, Field), wherein the needle has a distal end and the suture is attached to the distal end of the needle (see figs., Takamoto).

8. Takamoto/Field. discloses the invention substantially as claimed except for various locations of the suture-cutting blade. However, In re Japikse held that claims that read on the prior art except with regard to the position of a claimed element were held unpatentable if shifting the position of the claimed element would not have modified the operation of the device. 181 F.2d 1019; 86 USPQ 70 (CCPA 1950). Simple

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relocation of the suture-cutting blade does not modify the operation of the claimed device, but merely relocates the location of drawing the suture across the blade.

9. Claims 6, 7, 10, 17, 18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamoto et al. in view of Ogburn RE 22857.

10. Takamoto et al. teaches a suturing device comprising: a housing having a proximal end and a distal end (see. fig 1); a needle actuation handle (3 + 5) disposed at the proximal end of the housing; a shaft (1) at least partially disposed within a portion of the housing and extending distally from the distal end of the housing; and a needle movable within a needle lumen (see fig. 4) associated with the shaft and that extends toward a proximal end of the housing, the needle being attached to a length of suture, the needle (6) having a tapered tip, the tapered tip being initially oriented toward the distal end of the housing. It should be noted that Takamoto et al. fails to teach a suture cutting blade positioned on the housing.

11. Takamoto discloses the invention substantially as claimed except for various locations of the suture-cutting blade. However, In re Japikse held that claims that read on the prior art except with regard to the position of a claimed element were held unpatentable if shifting the position of the claimed element would not have modified the operation of the device. 181 F.2d 1019; 86 USPQ 70 (CCPA 1950). Simple relocation of the suture-cutting blade does not modify the operation of the claimed device, but merely relocates the location of drawing the suture across the blade.

12. Furthermore, Ogburn discloses that it is old and well known in the art to use a stationary suture cutting blade on the housing of a medical suturing device for the

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purpose of severing the suture after it has been applied to the wound (col. 1, lines 29-32; col. 2, lines 11-13; and col. 4, lines 3-10; See also figs. 1-3 and 11-13, reference numerals 51-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a stationary suture cutting blade near the proximal end of the housing, on an outside of the housing, on a finger grip on the housing, or on a movable handle of the device of Takamoto, in order to gain the advantage of being able to sever the suture after it has been applied to the wound, as taught by Ogburn.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G. M./  
Examiner, Art Unit 3734

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734